Docket No.: 243099US8

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/671,470
Applicants: Hiroyuki MENJO, et al.
Filing Date: September 29, 2003
For: WINNER DECIDING SYSTEM, WINNER DECIDING METHOD, WINNER DECIDING PROGRAM, AND COMPUTER-READABLE RECORDING MEDIUM
Group Art Unit: 2617
Examiner: HERRERA, D.

SIR:

Attached hereto for filing are the following papers:

Letter; Chinese Notice of Office Action with English Translation

Our check in the amount of **-0-** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Bradley D. Lytle
Registration No. 40,073

Zachary S. Stern
Registration No. 54,719

Customer Number
22850
(703) 413-3000 (phone)
(703) 413-2220 (fax)

DOCKET NO.: 243099US8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
Hiroyuki MENJO, et al.

SERIAL NO: 10/671,470 GROUP: 2617

FILED: September 29, 2003 EXAMINER: HERRERA, D.

FOR: WINNER DECIDING SYSTEM, WINNER DECIDING METHOD, WINNER DECIDING PROGRAM, AND COMPUTER-READABLE RECORDING MEDIUM

LETTER

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a Notice of Office Action with an English translation thereof issued January 12, 2007, in a corresponding Chinese patent application for the Examiner's consideration. The sole reference cited therein, U.S. Patent 6,320,495, was previously filed in an Information Disclosure Statement on July 6, 2004, and consideration of the reference was acknowledged by the Examiner on August 29, 2006.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Bradley D. Lytle
Registration No. 40,073

Zachary S. Stern
Registration No. 54,719

Customer Number
22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 03/06)

THE PATENT OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

Address: 6 Xi Tu Cheng Lu, Haidian, Beijing 100088

Applicant:	NTT DOCOMO, INC.	Date of Notification: Date: 12 Month: 01 Year: 2007
Attorney:	Kang jianzhong	
Application No.:	031601936	
Title of the Invention:	WINNER DECIDING SYSTEM, WINNER DECIDING METHOD, WINNER DECIDING PROGRAM, AND COMPUTER-READABLE RECORDING MEDIUM	

Rejection Decision

1. The above-identified application is rejected under Article 38 of the Patent Law and Rule 53 of the Implementing Regulations thereof. The rejection is made based on the ground that:
   - ☐ The application does not comply with Rule 2 paragraph 1 of the Implementing Regulations of the Patent Law.
   - ☐ The subject matter contained in the application is not patentable under Article 5 of the Patent Law.
   - ☐ The subject matter contained in the application is not patentable under Article 25 of the Patent Law.
   - ☒ The application does not comply with Article 22 of the Patent Law.
   - ☐ The application does not comply with the provisions of Rule 12 paragraph 1 of the Implementing Regulations of the Patent Law.
   - ☐ The applicant is not qualified for obtaining the patent right under Article 9 of the Patent Law.
   - ☐ The application does not comply with Article 26 paragraphs 3, 4 of the Patent Law.
   - ☐ The application does not comply with Article 31 paragraph 1 of the Patent Law.
   - ☐ The amendments to the application or the divisional application do not comply with Article 33 of the Patent Law.
   - ☐ The application does not comply with Rules 18-23 of the Implementing Regulations of the Patent Law.
   - ☐

   Details of the reasons for the rejection are recited in the text portion of the Rejection Decision(Total 2 pages).

2. The Rejection Decision is made based on the documents as specified below:
   claims _____, pages 3-11 of the description and drawings 1-6 filed on the date of filing,
   claims 1-8, pages 1, 2 of the description and drawings _____ submitted on 2006.10.30,
   claims _____, pages _____ of the description and drawings _____ submitted on _____,
   and the abstract submitted on 2003.09.29,

3. The applicant may, within 3 months counting from the date of receipt of this Notification, request the Patent Reexamination Board to make a reexamination under Article 43 of the Patent Law, if the applicant is not satisfied with the decision. The request for reexamination should be mailed or handed over to the Reception Division of the Patent Office.

Examination Dept. _____ Examiner: Shi gang Seal of the Examination Department

2207
98.10

TEXT OF THE REJECTION DECISION

CN Application No. 03160193.6

The present Rejection Decision relates to the patent application for invention No.03160193.6, entitled "WINNER DECIDING SYSTEM, WINNER DECIDING METHOD, WINNER DECIDING PROGRAM, AND COMPUTER-READABLE RECORDING MEDIUM" filed by the applicant NTT DOCOMO, INC. on September 29, 2003.

I. Brief of the case

Upon the request of the applicant for substantive examination on September 29, 2003, the examiner conducted substantive examination on the present application and the examination documents were the initial application documents. The examiner issued the first Office Action on January 20, 2006. The first Office Action cited Reference 1: US6320495B1 and pointed out that, Claims 1-8 do not possess inventiveness over Reference 1 and do not comply with Article 22.3 of the Chinese Patent Law (CPL), Claims 9-12 fall into the scope that is not patentable as provided in Article 25 of the CPL, and Claim 13 does not comply with Rule 20 of the Implementing Regulations of the Chinese Patent Law (IRCPL).

The applicant submitted a response to the first Office Action and newly amended claims and pages 1-2 of the description on July 4, 2006, in which the reasons why the newly amended Claims 1-8 possess inventiveness over Reference 1 were presented.

The examiner issued the second Office Action on August 18, 2006 and did not cite a new Reference. The second Office Action pointed out that, the amended Claims 1-8 still do not possess inventiveness over Reference 1, and thus the present application does not comply with Article 22.3 of the CPL.

The applicant submitted a response to the second Office Action and newly

amended claims and pages 1-2 of the description on October 30, 2006, in which the reasons why the newly amended Claims 1-8 possess inventiveness over Reference 1 were presented.

On the basis of the above work, the examiner deems that the truth of the case has been clear and the present Rejection Decision is made based on: the claims and Pages 1 and 2 of the description submitted on October 30, 2006, and Pages 3-11 of the description and accompanying drawings submitted on September 29, 2003.

II. Grounds for rejection:

1. Claim 5 does not possess inventiveness as required by Article 22.3 of the CPL over Reference 1.

Claim 5 seeks to protect a winner deciding method. Reference 1 (US6320495B1, published on November 20, 2001) has disclosed a treasure hunt game utilizing GPS equipped wireless communications devices, in which (see column 2, line 50 to column 5, line 48 of the description and Figs.1-4) the following technical features have been specifically revealed: each player is equipped with a mobile wireless communication device (10), which incorporates a GPS receiver (11); a "gamemaster" computer program (12) is designed to run the treasure hunt; the player's GPS receiver (11) receives navigation data from GPS satellites (13) and determines player locations; player locations are transmitted back to the gamemaster (14) by the player's wireless communication devices; the gamemaster determines the next clue to be given to a player based upon the player's location; that next clue is then transmitted to the player (15) and displayed on the player's wireless communication device; the player proceeds based on the clue to the treasure; the first player to arrive at the treasure wins the game. It can be seen that, Reference 1 has disclosed most of the technical features of the technical solution as claimed in Claim 5. Claim 5 differs from Reference 1 only in a) 当

選結果送信ステップ, b) 当選した移動機を少なくとも１つ決定するように、当選位置又はその範囲を設定する and c) 予備情報は、当該予備情報の有効期限を示す期限情報又は当該予備情報の有効期間を示す期間を示す期間情報とも関連付けられておる. Firstly, although Reference 1 only discloses the step of deciding a winner, it is a common knowledge for those skilled in the art to transmit the match result to the decided mobile devices and all the participants; secondly, it is also a common knowledge for those skilled in the art to decide one or more winning devices in game or match regions by changing game or match rules; thirdly, using "有効期限情報" and "有効期間の期間情報" as a limiting or associating condition to be as a premise of setting or deciding a winner is also a common knowledge to those skilled in the art. Therefore, those skilled in the art would obtain the inspiration for the technical solution as claimed in Claim 5 by combining the common knowledge with Reference 1. That is to say, such a combination is obvious to those skilled in the art, does not have prominent substantive features and fails to represent a notable progress. Therefore, the technical solution as claimed in Claim 5 does not possess inventiveness as required by Article 22.3 of the CPL.

a)の技術点は当業者に周知。

b)の技術点も当業者に周知。

c)の技術点も当業者に周知。

2. Claims 6 and 7 do not possess inventiveness as required by Article 22.3 of the CPL over Reference 1.

Dependent Claims 6 and 7 further define Claim 5 as follows: "wherein the preliminary information includes at least image information related to the wining location" and "wherein the preliminary information includes at least sound information related to the winning location", respectively. Reference 1 has disclosed (see column 5, lines 4-8 of the description) that the first clue related to the treasure hunt location is a riddle. It is a common knowledge for those skilled in the art to adopt text, image and/or sound as the preliminary information. Therefore, those skilled in the art would obtain the inspiration for the technical solutions as claimed in Claims 6 and 7 by combining the common

knowledge with Reference 1. That is to say, such a combination is obvious to those skilled in the art, does not have prominent substantive features and fails to represent a notable progress. Therefore, the technical solutions as claimed in Claims 6 and 7 do not possess inventiveness as required by Article 22.3 of the CPL either.

3. Claim 8 does not possess inventiveness as required by Article 22.3 of the CPL over Reference 1.

Dependent Claim 8 further defines claim 5, while Reference 1 has disclosed (see column 3, lines 5-18; column 5, lines 4-8 of the description, and Fig. 1) that player locations are located and transmitted to the gamemaster, and the gamemaster sends the corresponding first clue. Therefore, the technical solution as claimed in Claim 8 does not possess inventiveness as required by Article 22.3 of the CPL either.

4. Claims 1-4 do not possess inventiveness as required by Article 22.3 of the CPL over Reference 1.

Claims 1-4 are apparatus claims corresponding to method Claims 5-8. Based on the comments of items 1-3, for the same reasons, the technical solutions as claimed in Claims 1-4 do not possess inventiveness as required by Article 22.3 of the CPL either.

5. With respect to the arguments set forth by the applicant in the response, the examiner presents the following comments:

The applicant argued that, as compared to Reference 1, the inventiveness of the invention consists in "受信した位置情報が前記当選位置或は前記当選位置の許容範囲内に含まれると判断された全ての移動機のうちから当選した移動機を少なくとも 1 つ決定する". Reference 1 has disclosed that the first player to arrive at the treasure wins the game, and as set forth by the applicant

in the response, the player may be one person or a group of persons. Although Reference 1 does not define the allowable range containing the winning location, it is a common knowledge for those skilled in the art to decide the winner by setting the game or match rules, e.g. setting the first three persons to arrive at the treasure region are the winners. Therefore, the arguments of the applicant cannot be accepted.

III. Decision

In summary, the present application for invention does not possess inventiveness as required by Article 22.3 of the CPL, belongs to the circumstance as provided in Rule 53.2 of the IRCPL, and thus is rejected under Article 38 of the CPL.

Examiner: SHI Gang

Code: 9304

中华人民共和国国家知识产权局

邮政编码：100037
北京市阜成门外大街2号万通新世界广场8层
中国国际贸易促进委员会专利商标事务所
康建忠

E032613

申请号：031601936

发文日期

专利局 2007.1.12

申请人：株式会社NTT都科摩

发明创造名称：赢家确定系统、方法、程序及其计算机可读记录介质

驳回决定

1. 根据专利法第38条、实施细则第53条规定，决定驳回上述专利申请，驳回的依据是：
- ☐申请属于专利法第5条或者第25条规定的不授予专利权的范围。
- ☑申请不符合专利法第22条的规定。
- ☐申请不符合专利法第26条第3款或者第4款的规定。
- ☐申请不符合专利法第31条第1款的规定。
- ☐申请的修改不符合专利法第33条的规定。
- ☐申请不符合专利法实施细则第2条第1款的规定。
- ☐申请不符合专利法实施细则第13条第1款的规定。
- ☐申请不符合实施细则第20条第1款或者第21条第2款的规定。
- ☐申请的分案不符合专利法实施细则第43条第1款的规定。
- ☐ _____

详细的驳回理由见驳回决定正文部分（共 2 页）。

2. 本驳回决定是针对下述申请文件作出的：
申请日提交的原始申请文件的权利要求第 项、说明书第 3-11 页、附图第 1-6 页；
2006 年 10 月 30 日提交的权利要求第 1-8 项、说明书第 1,2 页、附图第 页；
年 月 日提交的权利要求第 项、说明书第 页、附图第 页；
2003 年 09 月 29 日提交的说明书摘要，2003 年 09 月 29 日提交的摘要附图。

3. 根据专利法第41条和专利法实施细则第59条的规定，申请人对本驳回决定不服，可以在收到本决定之日起叁个月内，向专利复审委员会请求复审。复审请求书应邮寄或递交给国家知识产权局专利局受理处。

审查员：石岗（9304）
2006 年 12 月 18 日

审查部门：[illegible]协作中心

专利审查业务章 105

回函请寄：100088 北京市海淀区蓟门桥西土城路6号 国家知识产权局专利局受理处收
（注：凡寄给审查员个人的信函不具有法律效力）

驳回决定正文

申请号：031601936

本决定涉及申请人株式会社NTT都科摩于2003年09月29日提交的、申请号为03160193.6、名称为"赢家确定系统、方法、程序及其计算机可读记录介质"的发明专利申请。

一、案由

应申请人于2003年09月29日提出的实审请求，审查员对上述申请进行了实质审查，审查文本是原始申请文件。审查员于2006年1月20日发出了第一次审查意见通知书，通知书中引用了一篇对比文件：

1 US6320495B1

通知书中指出，权利要求1－8相对于对比文件1不具备创造性，不符合专利法第22条第3款的规定；权利要求9－12属于专利法第25条规定的不授予专利权的范围；权利要求13不符合专利法实施细则第20条的规定。

申请人于2006年07月04日对第一次审查意见通知书提交了意见陈述书，提交了修改后的权利要求书与说明书1－2页，并在意见陈述书中论述了修改后的权利要求1－8相对于对比文件1具有创造性的理由。

审查员于2006年08月18日发出第二次审查意见通知书，未引用新的对比文件。通知书中指出，修改后的权利要求1－8相对于对比文件1仍不具备创造性，因此该申请不符合专利法第22条第3款的规定。

申请人于2006年10月30日对第二次审查意见通知书提交了意见陈述书，提交了修改后的权利要求书与说明书1－2页，并在意见陈述书中论述了修改后的权利要求1－8相对于对比文件1具有创造性的理由。

在上述工作的基础上，审查员认为该案事实已经清楚，针对2006年10月30日提交的权利要求书，说明书第1，2页，2003年09月29日提交的说明书3－11及附图，作出本驳回决定。

二、驳回理由

1、权利要求5相对于对比文件1不符合专利法第22条第3款有关创造性的规定。

权利要求5请求保护一种赢家确定方法，对比文件1（US6320495B1，公开日期：2001年11月20日）公开了一种利用配备有无线通信设备的GPS的寻宝游戏，其（参见其说明书第2栏50行－第5栏48行，图1－4）具体公开了：每一玩家配备有一移动无线通信设备（10），组合有GPS接收器（11），一"游戏主"计算机程序（12）被设计用于寻宝。玩家GPS接收器（11）从GPS卫星（13）接收导航数据并确定玩家位置。通过玩家无线通信设备，玩家位置被传送给游戏主（14）。游戏主根据玩家位置决定给玩家的下一线索。下一线索被传送给玩家（15）并被显示在玩家无线通信设备上。玩家根据线索前行，直至宝藏。第一个到达宝藏的玩家为胜利者。由此可见，对比文件1已经公开了权利要求5所请求保护的技术方案的大部分技术特征，它们的区别在于：a、获奖结果发送步骤；b、设定获奖位置或其范围以至少确定一个获奖的移动设备；c、初始信息还与表示该初始信息的有效期限信息或表示用于表示该初始信息的有效期间的期间信息相关联。首先，对比文件1尽管只公开确定胜利者的步骤，但将比赛结果发送至所确定的移动设备以及所有参与者，对本领域的技术人员来讲为公知常识；其次，通过改变游戏或比赛的规则，以确定游戏或比赛区域中的一个或多个获奖设备对本领域的技术人员来讲亦为公知常识；第三，将有效期限信息或有效期间的期

间信息作为限定条件或关联条件，以作为设定或判定赢家的前提，对本领域的技术人员来讲同样为公知常识，因此，本领域技术人员会在对比文件1的基础上结合公知常识，而得到权利要求5所要求保护技术方案的启示，也就是说这样的结合对本领域的普通技术人员来讲是显而易见的，不具备突出的实质性特点和显著的进步，因此权利要求5所要求保护的技术方案不符合专利法第二十二条第三款有关创造性的规定。

2、权利要求6和7相对于对比文件1不符合专利法第22条第3款有关创造性的规定。

从属权利要求6和7对权利要求5的进一步限定分别为"其中该初始信息包括至少与该获奖位置相关的图像信息"和"其中该初始信息包括至少与该获奖位置相关的声音信息"，对比文件1（参见第5栏第4－8行）公开了：与寻宝位置相关的第一线索为一谜语。而采用文字，图像和／或声音来作为初始信息对本领域的技术人员来讲为公知常识。因此，本领域技术人员会在对比文件1的基础上结合公知常识，而得到权利要求6和7所要求保护技术方案的启示，也就是说这样的结合对本领域的普通技术人员来讲是显而易见的，不具备突出的实质性特点和显著的进步，因此权利要求6和7所要求保护的技术方案也不符合专利法第二十二条第三款有关创造性的规定。

3、权利要求8相对于对比文件1不符合专利法第22条第3款有关创造性的规定。

从属权利要求8对权利要求1作了进一步限定，对比文件1（参见第3栏5－18行，第5栏4－8行，图1）公开了：玩家位置被定位并传送给游戏主，游戏主发送相应的第一线索。因此权利要求8所要求保护的技术方案也不符合专利法第二十二条第三款有关创造性的规定。

4、权利要求1－4相对于对比文件1不符合专利法第22条第3款有关创造性的规定。

权利要求1－4为相应于方法权利要求5－8的装置权利要求，根据驳回理由的第1－3点的审查意见，同理权利要求1－4所请求保护的技术方案同样不符合专利法第二十二条第三款有关创造性的规定。

5、针对申请人意见陈述书中的理由，审查员意见如下：

申请人认为，与对比文件1相比，该发明的创造性在于"从所接收的位置信息被判断为是所述获奖位置或者被包含在所述获奖位置的容许范围内的所有移动设备中，至少确定一个获奖的移动设备"。对比文件1公开了最早到达宝藏的玩家为胜利者，正如申请人在意见陈述书中所述：其可为1人或1组人。尽管其没有对包含所述获奖位置的容许范围进行限定，但通过对比赛或游戏的规则进行设定，如设定先进入宝藏所在区域前三人为获胜者，由此确定获胜者，这对本领域技术人员来讲为公知常识。因此，申请人的上述理由不能成立。

三、决定

综上所述，该发明专利申请不符合专利法第22条第3款有关创造性的规定，属于专利法实施细则第53条之（二）项的情况，因此，根据专利法第38条予以驳回。

审查员：石岗

代码：9304